

REMARKS

I. Status of the Claims

Applicants would like to thank the Examiner and her Supervisor for making time to speak with the Applicants' counsel on February 6, 2004.

Claims 1-112 are pending in this application. Claims 1, 15, 96, 105, 106, 108, and 112 have been amended to describe the additional silicone as insoluble. The amendments are supported by the specification (see, e.g., Specification at page 6, lines 12-15: "The silicones, other than the silicone copolymer of the invention . . . that can be used in accordance with the invention can, for example, be chosen from polyorganosiloxanes that are insoluble in the composition . . .") and the claims as-filed (see, e.g., claim 15). Accordingly, no new matter has been added by these amendments, nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Office.

In addition to the claim amendments, Applicants submit a Declaration under 37 C.F.R. § 1.132. This Declaration presents experimental results that demonstrate improved properties of the presently claimed invention.

II. Provisional Obviousness-Type Double Patenting Rejection

The Examiner has provisionally rejected claims 1-14 and 41-104 under the judicially created doctrine of double-patenting as being unpatentable over claims 1-83 of co-pending Application No. 09/692,360; claims 1-95 of co-pending Application No. 09/692,155; and claims 1-16, 37-104 of co-pending Application No. 09/692,716.

Applicants acknowledge and thank the Examiner for agreeing, during the interview on

August 26, 2003, to hold the provisional double-patenting rejection of these claims in abeyance until allowable subject matter has been indicated. At that time, Applicants will consider whether or not it is appropriate to file a Terminal Disclaimer.

III. Rejections Under 35 U.S.C. § 103(a)

The Examiner has issued the following rejections under 35 U.S.C. § 103(a):

- (A) claims 1-31, 38-67, and 94-112 as being unpatentable over Dalle *et al.* (EP 0874017) ("Dalle") in view of Dubief *et al.* (U.S. Pat. No. 5,650,383) ("Dubief '383") and Restle *et al.* (U.S. Pat. No. 6,039,936) ("Restle") (Final Office Action at 2-4);
- (B) claim 32 as being unpatentable over the Dalle/Dubief '383/Restle combination further in view of Grollier *et al.* (U.S. Patent No. 5,063,051) (Grollier '051) (Final Office Action at 4);
- (C) claim 33 as being unpatentable over the Dalle/Dubief '383/Restle/Grollier '051 combination further in view of Grollier *et al.* (U.S. Patent No. 4,957,732) ("Grollier '732") (Final Office Action at 5);
- (D) claims 34-37 as being unpatentable over the Dalle/Dubief '383/Restle/Grollier '051/Grollier '732 combination further in view of Dubief *et al.* (U.S. Patent No. 6,011,126) ("Dubief '126") (Final Office Action at 6); and
- (E) claims 68-93 as being unpatentable over the Dalle/Dubief '383/Restle/Grollier '051/Grollier '732/ Dubief '126 combination further in view of Inman (U.S. Patent No. 5,948,739) ("Inman") (Final Office Action at 7).

Applicants continue to respectfully traverse these rejections for at least the reasons of record and for the additional reasons set forth below. As an initial matter, the Examiner has yet to establish a *prima facie* case of obviousness. In particular, the

references cited by the Examiner in the current rejections do not teach or suggest all of the claim limitations, nor is there any suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine references, and the Examiner has not shown a reasonable expectation of success in making a combination of the references. See M.P.E.P. § 2143. Thus, the Examiner has failed to meet any, let alone all three criteria required for a *prima facie* showing of obviousness.

According to the Examiner, “Dalle teaches silicone- in- water emulsions comprising the polysiloxanes of formula (I) and at least one surfactant among anionic, nonionic, amphoteric, and cationic surfactants.” Final Office Action at 2. Although the Examiner admits that Dalle does not teach the additional silicone recited in claims 15-40, she asserts that Dubief ‘383 remedies this deficiency because it “teaches composition[s] for washing and rinsing hair, which comprise water-insoluble silicone in an aqueous medium and surfactants” and that the “polyorganosiloxanes in claims 15-31 and 38 are disclosed in col. 2, line 66 - col. 6, line 8.” Final Office Action at 3. The Examiner further asserts that “Restle et al. teach an oil-in-water emulsion comprising a silicone surfactant and at least one cationic amphiphilic lipid that is a quaternary ammonium salt of formulas (IV) - (VII) and their constituents in the instant claims 41-67.” *Id.*

Based on this combination of references, the Examiner has concluded that “[a]ll components are known in the art. Nothing unexpected or nonobvious is seen in combining old and well-known compounds for the same use.” Office Action at 4. In response to Applicants’ previous arguments that there is no motivation to combine Dalle

and Dubief, the Examiner merely states that “both of the Dalle and Dubief ['383] inventions are applicable to personal care compositions, particularly hair washing and/or conditioning compositions. . . . Examiner reiterates that the combination would have been obvious in view of the expected additive effects.” Office Action at 9. The Examiner does not proffer any proof on this point as is required. Further, the Examiner misapplies In re Kerkhoven, 626 F.2d 848 (CCPA 1980) to support the rejection, asserting that the idea for combining Dalle and Dubief '383 “flows logically from their having been used individually in the prior art.” Office Action at 9.

Applicants respectfully traverse the rejections for at least the following reasons.

First, Applicants point out that the application as presently amended relates to a cosmetic composition comprising

- (1) at least one silicone copolymer of a specific viscosity,
- (2) at least one additional silicone comprising an insoluble silicone, and
- (3) at least one cationic surfactant.

Thus, the present invention differs from Dalle in many ways, for example, it possesses additional benefits resulting from its additional components. These benefits, including those associated with the additional silicone, are not suggested by either Dalle or Dubief '383 in a manner that would have motivated one of ordinary skill in the art to combine the teachings of Dalle and Dubief '383. An obviousness rejection based on a combination of references requires the references to suggest the desirability of the combination. See M.P.E.P. § 2143.01. As the Federal Circuit has noted, “case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a

showing of the teaching or motivation" of the art. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Examiner must make particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components of the claimed invention for combination in the manner claimed. See *In re Katzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Further, the Examiner has erroneously argued that she does not have to show any reasonable expectation of success of the combination, only that there was a motivation to make such a combination. Such a statement directly contradicts M.P.E.P. § 2143.02.

Dubief '383 teaches an insoluble silicone in an emulsion comprising a copolymer of diallyldialkylammonium and of an anionic monomer. Further to the phone conversation with the Examiner on February 6, 2004, Applicants respectfully assert that the teaching in Dubief '383 of the "polyorganosiloxanes . . . disclosed in col. 2, line 66 - col. 6, line 8," Office Action at 3, is cumulative of Dalle, and thus is not a teaching that cures the deficiencies of Dalle.

The presently claimed invention recites an additional insoluble silicone separate and distinct from the polyorganosiloxanes comprising the part of the copolymers of the emulsion of Dubief '383. The Examiner argues that Dubief '383 has a teaching that would motivate its combination with Dalle, specifically that "Dubief ['383] also teaches that cationic surfactants or additional silicones may be added in the invention. See col. 7, lines 56-67." Final Office Action at 9. Applicants respectfully disagree with the Examiner and assert that Dubief '383 does not teach, motivate or suggest a likelihood of success in combining an insoluble silicone with a polyorganosiloxane emulsion. In fact, Dubief '383 specifically teaches away from the addition of an insoluble silicone.

In particular, the passage from Dubief '383 that the Examiner relies on states that . . . compositions according to the invention may optionally also contain other agents whose effect is to improve the properties of keratinous matter . . . **on condition that they do not impair the stability of the compositions**, such as cationic surface-active agents . . . or else **silicones which are soluble in the mixture**. Dubief '383, col. 7, lines 56-67 (emphasis added). Thus, Dubief '383 teaches only the possible addition of silicones that are soluble in the mixture, and which do not impair the stability of the compositions, contrary to the presently claimed invention, which recites an insoluble additional silicone. See amended claim 1. In an obviousness determination, the Examiner must consider the reference teachings as a whole, taking into consideration portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02; see also M.P.E.P. § 2145(D).

The Examiner also argues that it is obvious to combine Dalle and Dubief because of their individual uses in the prior art, relying on the rationale of In re Kerkhoven. However, Applicants respectfully argue that the facts of Kerkhoven are not applicable to the present case. In Kerkhoven, the appealed claims were directed to a process for forming a detergent, comprising forming two aqueous slurries, where one slurry was predominantly an anionic detergent and the other was primarily a nonionic detergent, independently or simultaneously drying the slurries, and mixing the resulting products. See 205 U.S.P.Q. at 1070. It was acknowledged that prior art detergents comprised a mixture of anionic fatty acid soaps, anionic detergents, and nonionic detergents. Id. To make the known detergents, all of the ingredients were combined together in one slurry and then spray dried. Id. Therefore, the court held that the claims

at issue requiring “*no more than the mixing together*” of two conventional detergents to make a third detergent composition set forth “*prima facie obvious subject matter.*” *Id.* at 1072 (emphasis added).

There are several key differences between the present invention and the invention at issue in Kerkhoven. First, and most importantly, the end product in Kerkhoven was the same as the two combined ingredients: a detergent. In the present invention, the claimed elements are combined to create a conditioner. Contrary to the Examiner’s assertion, the literal combination of Dalle and Dubief ‘383 would not give rise to the claimed invention. Thus, the Examiner’s application of *In re Kerkhoven* is inapposite to the present case.

Moreover, the combination of Dalle/Dubief ‘383/Restile cited by the Examiner fails to contain all elements of the invention, because each of the cited references only teach the need for one silicone. The present invention is a composition comprising a silicone copolymer emulsion having a particularly defined viscosity and a cationic surfactant, as well as an additional silicone that is insoluble. The cited references only discuss and disclose compositions requiring only one silicone. Dubief ‘383 may teach the optional addition of a soluble silicone, but, as discussed above, the teaching of Dubief ‘383 cannot be construed to teach or motivate the combination of the present invention, because it actually teaches away from the claimed invention. Thus, even if the three references were combined, they do not result in the claimed invention: a composition with a cationic silicone emulsion comprising an additional silicone that is insoluble, and at least one cationic surfactant. Rather, the combination of references results in

compounds comprising a silicone emulsion, wherein the emulsion may comprise the various types of silicones disclosed in the cited references.

By its very nature, an obviousness rejection is based on the assumption that similar compositions will exhibit similar properties. The Examiner has argued that the asserted "combination would have been obvious in view of the expected additive effects." Office Action at 9. However, as shown in the attached declaration under 37 C.F.R. § 1.1.32, this is not the case for the present obviousness rejection. Rather, the compositions of the prior art exhibit substantially inferior properties, namely ease of disentangling, than does the claimed composition. As the tests indicate, and the declarant attests to, this result is directly attributed to the use of an insoluble silicone.

In addition to all of the deficiencies of the Examiner's rejection discussed above, the references relied on by the Examiner do not suggest the improved properties of the claimed invention. Thus, Applicants submit that the experimental results further demonstrate the improved properties of the presently claimed invention over the prior art, which does not remotely suggest such properties. See Declaration under 37 C.F.R. § 1.132

For at least the foregoing reasons, the Examiner has failed to show that the Dalle/Dubief '383/Restle combination does not contain each of the claimed elements of the claimed invention, the references do not provide a teaching that would motivate their combination, nor do the references provide a reasonable expectation of success in their combination. As the Examiner has failed to satisfy her burden under 35 U.S.C. § 103, with respect to the primary combination of references, *i.e.*, Dalle/Dubief '383/Restle, Applicants respectfully submit that this combination and all other combinations with

secondary references (i.e., Grollier '732, Dubief '126, and Inman) relying on Dalle/Dubief '383/Restle are improper. Accordingly, Applicants respectfully request withdrawal of all § 103 rejections.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the consideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 4, 2004

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